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Martin Fisher

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EXAMINER

WALCZAK, DAVID J

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/516,388	<b>Applicant(s)</b> FISHER, MARTIN	
	<b>Examiner</b> David J. Walczak	<b>Art Unit</b> 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-51,67-71,73 and 74 is/are pending in the application.
- 4a) Of the above claim(s) 27-32,40-44,51 and 68-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26,33-39,45-50,67,73 and 74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election***

Applicant's election without traverse of Group I, Species I, Sub-Species B in the replies filed on 5/27/08, 9/19/08 and 12/16/08 is acknowledged.

The Applicant contends that claims 1-26, 33-39, 44-50, 67-71, 73 and 74 are readable on the elected Group, Species and Sub-Species. However, as claim 44 depends from withdrawn claim 43, claim 44 is also considered to be withdrawn.

Further, claims 68 and 69 define a grip having a displacement range limited by a stop member while the elected embodiment does not include such structure. These claims appear to be directed to Species III, Figure 15 (see, for example, page 21, lines 16-25). Accordingly, claims 68 and 69 are also considered to be withdrawn. See also claim 27, which has been withdrawn by the Applicant as being directed to a non-elected embodiment and also defines a stop member.

Also, claim 70 defines an extension handle extending from the distribution means to the biasing means while the elected embodiment does not include such structure. This claim also appears to be directed to Species III as the extension handle shown in Figure 17 is disclosed as being usable with the embodiment in Figure 15 (see, for example, page 20, lines 23-28 and page 22, lines 16-17). Accordingly, claim 70 is also considered to be withdrawn. See also claim 28, which has been withdrawn by the Applicant as being directed to a non-elected embodiment and also defines an extension handle.

Lastly, claim 71 defines a slot outlet and a paint canister having an elongated cross-section while the elected embodiment does not include such structure. This claim appears to be directed to Species III, Figure 15 (see page 21, lines 5-12). Accordingly, claim 71 is also considered to be withdrawn. See also claim 32, which has been withdrawn by the Applicant as being directed to a non-elected embodiment and also defines the elongated paint container.

In summary: Claims 1-26, 33-39, 45-50, 67, 73 and 74 are considered to read on the elected embodiment and will be examined herein. Claims 27-32, 40-44, 51 and 68-71 are considered to be withdrawn as they are directed to non-elected embodiments and claims 52-66, 72 and 75 have been canceled.

### ***Abstract***

The abstract of the disclosure is objected to because phrases that can be implied, such as "is provided" and "The application also includes" (see lines 1 and 3) should not be present therein. Further, the abstract should be presented on a separate sheet. Correction is required. See MPEP § 608.01(b).

### ***Specification***

The disclosure is objected to because of the following informalities:

On page 9, line 8, "Fig. 18" should be --Figs 18a and 18b-- (there is no Figure 18);

On page 10, line 5, "telescopic ally" should be --telescopically--;

On page 10, line 31, "includes a hood 70 includes side" should be --includes a hood 70 *and* includes side";

On page 11, lines 19 and 20, it appears that "slot 84" should be --groove 88-- (see page 14, lines 15-18); and

On page 11, lines 28, 29 and 30, "gripping portion 32" should be --gripping portion 30-- (see page 10, line 6-7).

The Applicant should review the entire specification to ensure that any other such minor errors are corrected.

Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The terms "expansion cavities" (claim 67) and "cam" (claim 73) do not have antecedent basis in the specification. The Applicant should review all of the claims to ensure that all of the terms therein have a proper antecedent basis in the specification.

### ***Claim Rejections - 35 USC § 112***

Claims 1-26, 33-39, 45-50, 67, 73 and 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In regard to claim 1, on line 4, the phrase "an operator in use" is indefinite in that this language seems to imply that an operator is being claimed and a person is not proper statutory subject matter. Further, on line 5, the phrase "the flow of paint distribution means" is indefinite in that this language seems to imply that the distribution means flows, as opposed to the paint flowing onto the distribution means.

In regard to claim 7, the phrase "and normally" is indefinite in that the metes and bounds of the claim have not been clearly defined.

In regard to claim 8, the phrase "the passages" is indefinite in that claim 7 requires only "at least one" passage.

In regard to claim 9, the phrase "the row of passages" is indefinite in that claim 7 requires only "at least one" passage.

In regard to claim 39, the phrase "may include a gripping portion" is indefinite in that the metes and bounds of the claim have not been clearly defined.

In regard to claim 67, it is unclear as to whether or not the roller and paint are intended to be part of the claimed combination. Should the Applicant intend to claim these elements, an antecedent basis for the roller and paint should be defined. Should the Applicant not intend to claim these element, "adapted to be/for" language should be used when referring thereto. Also in regard to claim 67, the phrase "by provision of expansion cavities" is unclear, i.e., it appears that this structure has already been defined as "paint traps" in this claim.

In regard to claim 73, the phrase "--between a roller surface and "the outlet on one side on the other side" in the roller direction-- is unclear.

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In regard to claim 74, it appears that "slot" (see line 1) should be --aperture-- since the specification discloses that pin 80 is positioned within aperture 98 (see page 11, lines 16-17) and the slots 84 are disclosed as being able to receive a screwdriver, and not the pins. Further, an antecedent basis for "the respective sides of the outlet" has not been defined. Further in regard to claim 74, the phrase "varying width between the respective sides of the outlet" is indefinite, i.e., this language implies that a distance between sides of the outlet vary while it is the distance between the roller and the outlet that actually can be varied.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 33, 35-39 and 45-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al. (hereinafter Clark).

In regard to claim 1, Clark discloses an applicator for applying paint comprised of a body 11 for paint, a paint distribution means 78, paint biasing means 50 and control means 32, 33, 55 for controlling the bias means wherein biasing means applies incremental axial displacement of the paint, i.e., upon each operation of handle 33, an incremental displacement of paint will occur.

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In regard to claim 2, the paint distribution means is releasably engageable with the body (at element 92, see column 4, lines 46-59) and forms a separable applicator head.

In regard to claim 3, the head includes mounting means for rotatably mounting a roller (see column 4, lines 14-15).

In regard to claim 33, the body includes refilling means (see column 4, lines 71-74).

In regard to claim 35, the paint biasing means includes a plunger 50 for biasing the paint to the paint distribution means.

In regard to claim 36, the plunger includes a rod 25 which extends along the body from a plunger head acting on the paint.

In regard to claim 37, the body 11 defines a handle in the form of a tube having a passage therethrough.

In regard to claim 38, the rod 25 extends into and along the handle.

In regard to claim 39, the rod extends beyond the handle and includes a gripping portion 27 at its distal end.

In regard to claim 45, the control means includes a trigger 33 mounted adjacent to the handle.

In regard to claim 46, a linkage 60, 65 is operable by the trigger to advance the plunger.

In regard to claim 47, the linkage includes a link plate 60 having an over-sized aperture through which the rod 25 passes.

In regard to claim 48, the link plate is biased toward the trigger (via spring 43) and engages the plunger as claimed.

In regard to claim 49, connection means 92 is positioned between the applicator head and the body.

Claim 67 is rejected under 35 U.S.C. 102(b) as being anticipated by Jansen.

Jansen discloses an applicator comprised of a roller 14, an applicator head 12 and paint biasing means 25 wherein the head includes "paint traps"/"expansion cavities" on either side of the roller (viewing Figure 5, the gaps between sidewalls 40A, 40B and roller edges 16A, 16B define the claimed "paint traps") for accommodating excess paint flow from the paint biasing means.

Claims 73 and 74 are, as best understood, rejected under 35 U.S.C. 102(b) as being anticipated by Liou.

In regard to claim 73, Liou discloses a paint applicator comprised of a roller 5 secured through a cam 53, 421 whereby the roller rotates with a "rollover rotation" past a paint outlet 1 characterized in that the rollover rotation is "eccentric with differing gap widths" between a roller surface and the outlet (i.e., the connection 53, 421 enables the gap between the roller and sides of the outlet to differ).

In regard to claim 74, a slot 421 is provided within which a pin 53 is secured for provide for eccentric rotation and the varying width between sides of the outlet.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-14 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Bennett.

In regard to claim 4, although the applicator head in the Clark device does not include a hood for enclosing the roller, attention is directed to the Bennett reference, which discloses another paint roller applicator wherein an applicator head includes a hood 22 in order to shield from paint splatter and in order to enable paint to be effectively applied to the outer surface of the roller. Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made that the paint feeding device disclosed by Clark, i.e., the paint feeder inside of the roller, can be replaced with the paint feeding device disclosed by Bennett, i.e., an applicator head having a hood which enables paint to be applied directly to the outer roller surface, in order to enable a user to apply paint directly to the outer surface of the roller (as opposed to channeling paint through the roller). Further, such a modification would amount to the mere substitution of one functionally equivalent mechanism for transferring paint to a roller for another and the selection of either mechanism would work equally well on the Clark device.

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In regard to claim 5, the applicator head in the Bennett device includes a flow regulation means 28, 32 to regulate the flow of paint to the roller surface.

In regard to claim 6, the flow regulation means includes a gap (see Figure 3) between a distribution means surface (i.e., the roller surface) and the hood.

In regard to claim 7, the head includes a passage 26 therein.

In regard to claim 8, the passage is arranged as a row that runs parallel to the axis of the distribution means.

In regard to claim 9, passage 26 extends "substantially" the width of the surface.

In regard to claim 10, although the Bennett reference does not disclose the dimensions of the passage with respect to the roller surface, it is the Examiner's position that the passage can be designed to have any suitable length, including the claimed length, without effecting the overall operation thereof.

In regard to claim 11, the gap is at a minimum at the passage (see Figure 3).

In regard to claim 12, the hood 22 includes a concave internal surface.

In regard to claim 13, the hood has a different radius than the roller surface.

In regard to claim 14, the hood has a larger radius than the roller surface.

In regard to claim 34, although Clark reference does not disclose the specific structure of the releasable connection that enables the refilling thereof, it is the Examiner's position that any suitable releasable connection, including a threaded connection, can be used to connect the two elements without effecting the overall operation thereof.

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Claims 1-14, 26 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennet in view of Clark.

In regard to claim 1, Bennett discloses a paint applicator comprised of a body for paint, a paint distribution means 14 and a control means for controlling the flow of paint. Although the Bennett device does not include the claimed paint biasing means, attention is directed to the Clark reference which, as discussed above, discloses another paint applicator having the claimed body and biasing means which incrementally displaces the paint. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the paint biasing means and body disclosed in the Bennett reference with the paint biasing means/body disclosed by Clark as such a modification would amount to the mere substitution of one functionally equivalent paint biasing means for another and the selection of either of these paint biasing means would work equally well on the Bennett paint distribution means.

In regard to claim 2, the paint distribution means would be releasably engageable with the body (as disclosed by Clark and as discussed above) and thereby form a separable applicator head.

In regard to claim 3, the head in the Bennett device includes means for rotatably mounting a roller.

In regard to claims 4-14, as discussed above, the Bennett device discloses the claimed structure.

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In regard to claim 26, a paint trap 22 is provided adjacent to the roller in the Bennett device.

In regard to claim 49, a connection means is disposed between the applicator head and the body.

Claims 15-21, 24, 25 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Clark as applied to claim 2 above, and further in view of Calvert.

In regard to claims 24, 25 and 50, although the mounting means for the roller in the Bennett device is not disclosed as being adjustable, attention is directed to the Calvert reference, which discloses another paint roller wherein the roller mounting means 25a, 25b enable the position of the roller to be removed from the head and adjusted (i.e., angled with respect to the paint distribution means, see the paragraph bridging columns 3 and 4). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made that that the roller in the Bennett device can also be mounted in an adjustable fashion in order to enable a user to adjust the position of the roller.

In regard to claim 15, at least one of the two positions of the roller would render the roller surface not concentric with the hood surface.

In regard to claim 16, the roller and hood surfaces diverge away from each other (see Figure 3).

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In regard to claim 17, the head includes a recess 28 in the hood which leads to the passage.

In regard to claim 18, the recess forms a plenum chamber.

In regard to claims 19 and 20, although the Bennett reference does not disclose the claimed dimensions of the recess and distribution means, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the recess and distribution means can be designed to have any suitable dimensions, including those claimed, without effecting the overall operation of the device.

In regard to claim 21, the gap is at a minimum near the edges of the recess.

### ***Allowable Subject Matter***

Claims 22 and 23 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huson Gregory can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David J. Walczak  
Primary Examiner  
Art Unit 3751

DJW  
1/28/09

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